



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/511,498	10/15/2004	Dennis Mark Lettkeman	2033.67345	4629

24978 7590 04/11/2006

GREER, BURNS & CRAIN
300 S WACKER DR
25TH FLOOR
CHICAGO, IL 60606

EXAMINER

GREEN, ANTHONY J

ART UNIT	PAPER NUMBER
----------	--------------

1755

DATE MAILED: 04/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/511,498

Applicant(s)

LETTKEMAN ET AL.

Examiner

Anthony J. Green

Art Unit

1755

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 February 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 21 is/are allowed.
- 6) ☒ Claim(s) 1-20 and 22-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. This office action is in response to the amendment submitted on 21 February 2006. Claims 23-25 have been added and accordingly claims 1-25 are currently pending in the application.

Terminal Disclaimer

2. The terminal disclaimer submitted on 21 February 2006 is acceptable and has been recorded.

Inventorship

3. The petition to correct inventorship submitted on 21 February 2006 has been reviewed and is not acceptable for the following reason:

The petition was submitted under the wrong rule. Applicant has submitted the petition under rule 1.324 which is incorrect as this rule is for the correction of inventorship in a patent, not a patent application. The correct rule is 1.48. Upon submission of a proper petition the request to correct inventorship will be reconsidered.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

Art Unit: 1755

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1, 10, 12, and 14-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Patel (US Patent No. 5,653,797).

The reference teaches, in the Tables, compositions comprising water, preservatives, retarder, calcium sulfate hemihydrate, mica, clay, a cellulose thickener, a latex binder and an accelerator. See also the examples. Column 7, lines 12+, teaches that defoamers can be added usual amounts of from 0.1% to about 50% by weight of the composition.

The instant claims are rendered obvious by the reference as the reference suggests compositions that encompass that which is instantly claimed thus rendering obvious claims 1 and 10. As for the amount of water recited in claim 14, the reference teaches amounts that encompass (overlap) that which is instantly claimed. One of ordinary skill in the art at the time the invention was made would have considered the invention to have been obvious because the compositional proportions taught by the reference overlap the instantly claimed proportions and therefore are considered to establish a prima facie case of obviousness. It would have been obvious to one of ordinary skill in the art to select any portion of the disclosed ranges including the instantly claimed ranges from the ranges disclosed in the prior art reference, particularly in view of the fact that;

“The normal desire of scientists or artisans to improve upon what is already generally known provides the motivation to determine where in a disclosed set of percentage ranges is the optimum combination of percentages”, In re Peterson 65 USPQ2d 1379 (CAFC 2003).

Art Unit: 1755

Also, In re Geisler 43 USPQ2d 1365 (Fed. Cir. 1997); In re Woodruff, 16 USPQ2d 1934 (CCPA 1976); In re Malagari, 182 USPQ 549, 553 (CCPA 1974) and MPEP 2144.05.

Column 5, lines 34+ teaches that either alpha or beta calcium sulphate hemihydrate may be utilized. As for claims 12 and 19 the reference suggests the use of defoamers in usual amounts ranging from about 0.1% to about 50% of the composition. As for the type of setting rate retarder (claim 20), while the reference does not teach the use of the same types, applicant's particularly claimed types are all well known types in the art and accordingly their use would have been obvious to one of ordinary skill in the art. As for claims 23-24

6. Claims 1-17, 20 and 23-24 rejected under 35 U.S.C. 103(a) as being unpatentable over Immordino, Jr. et al (US Patent No. 6,673,144).

While it is noted that applicant's have submitted a petition to add Salvatore C. Immordino Jr to the application as an inventor, as stated above the petition is improper. Upon submission of an acceptable petition the following scenario would be applicable: Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR

Art Unit: 1755

1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). This rejection might also be overcome by showing that the reference is disqualified under 35 U.S.C. 103(c) as prior art in a rejection under 35 U.S.C. 103(a). See MPEP § 706.02(I)(1) and § 706.02(I)(2).

The reference teaches in column 3, lines 65+, a joint compound comprising a filler, a binder, a thickener and a synthetic polymer wax. The filler may be calcined gypsum see column 6, lines 14+). The synthetic wax may be a polyethylene wax (see column 4, lines 5+). The binder may be selected from various latex emulsion or spray dried powders (see column 7, lines 10+). The thickening agent may include cellulose, gums, etc. (see column 7, lines 52+).

The instant claims are obvious over the reference. The reference provides the motivation for the formation of a composition that encompasses that which is instantly claimed based on its disclosure of the various materials that may be utilized as the filler, binder, thickener etc. As for the amounts of the components the reference teaches amounts that encompass (overlap) that which is instantly claimed. One of ordinary skill in the art at the time the invention was made would have considered the invention to have been obvious because the compositional proportions taught by the reference overlap the instantly claimed proportions and therefore are considered to establish a prima facie case of obviousness. It would have been obvious to one of ordinary skill in the art to select any portion of the disclosed ranges including the instantly claimed

Art Unit: 1755

ranges from the ranges disclosed in the prior art reference, particularly in view of the fact that;

“The normal desire of scientists or artisans to improve upon what is already generally known provides the motivation to determine where in a disclosed set of percentage ranges is the optimum combination of percentages”, In re Peterson 65 USPQ2d 1379 (CAFC 2003).

Also, In re Geisler 43 USPQ2d 1365 (Fed. Cir. 1997); In re Woodruff, 16 USPQ2d 1934 (CCPA 1976); In re Malagari, 182 USPQ 549, 553 (CCPA 1974) and MPEP 2144.05. With respect to claims 2-4 and 13 it is the position of the examiner that the references disclosure of the use of various polyethylene glycols waxes meets these limitations. As for claims 5 and 11 it is the position of the examiner that the references disclosure of the use of various polyethylene glycols waxes meets these limitations. Claims 6-8 are believed to be met by the use of ethylene vinyl acetate copolymers (see column 7, lines 10+). With respect to the molecular weight of the polyethylene glycol (claim 4), this appears to be a matter of obvious choice or design best determinable through routine experimentation and optimization within the art and producing no unexpected results, absent evidence showing otherwise as the reference teaches the use of similar types. As for the molecular weight of the polysaccharide (claim 9) this too appears to be a matter of obvious choice or design best determinable through routine experimentation and optimization within the art and producing no unexpected results, absent evidence showing otherwise as the reference teaches the use of similar types. As for claim 12 the claim reads on no defoamer being present. Claims 23-24 are

met by the references disclosure of the types of thickeners, column 7, lines 52+).

Accordingly the instant claims are obvious over the reference.

7. Claims 1-13 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Immordino (US Patent No. 6,406,537).

While it is noted that applicant's have submitted a petition to add Salvatore C. Immordino Jr to the application as an inventor, as stated above the petition is improper. Upon submission of an acceptable petition the following scenario would be applicable: Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). This rejection might also be overcome by showing that the reference is disqualified under 35 U.S.C. 103(c) as prior art in a rejection under 35 U.S.C. 103(a). See MPEP § 706.02(I)(1) and § 706.02(I)(2).

The reference teaches in column 4, lines 33+) a joint compound comprising calcined gypsum in the form of calcium sulfate alpha or beta hemihydrate. The composition may further contain a trimetaphosphate salt (column 5, lines 12+), a water soluble linear polymer such as polyethylene glycol (column 5, lines 65+). The composition may include other ingredients such as a thickening agent which may be a cellulose or gum (see column 7, lines 4+) and a binder such as polyvinyl acetate (see column 7, lines 25+).

The instant claims are obvious over the reference. The reference provides the motivation for the formation of a composition that encompasses that which is instantly claimed based on its disclosure of the various materials that may be utilized as the filler, binder, thickener etc. As for the amounts of the components the reference teaches amounts that encompass (overlap) that which is instantly claimed. One of ordinary skill in the art at the time the invention was made would have considered the invention to have been obvious because the compositional proportions taught by the reference overlap the instantly claimed proportions and therefore are considered to establish a prima facie case of obviousness. It would have been obvious to one of ordinary skill in the art to select any portion of the disclosed ranges including the instantly claimed ranges from the ranges disclosed in the prior art reference, particularly in view of the fact that;

“The normal desire of scientists or artisans to improve upon what is already generally known provides the motivation to determine where in a disclosed set of percentage ranges is the optimum combination of percentages”, In re Peterson 65 USPQ2d 1379 (CAFC 2003).

Also, In re Geisler 43 USPQ2d 1365 (Fed. Cir. 1997); In re Woodruff, 16 USPQ2d 1934 (CCPA 1976); In re Malagari, 182 USPQ 549, 553 (CCPA 1974) and MPEP 2144.05.

With respect to claims 2-5, 11 and 13 it is the position of the examiner that the references disclosure of the use of various polyethylene glycols as a water soluble linear polymer meets these claim limitations. Claims 6-8 and 11 are believed to be met by the references disclosure of the use of ethylene vinyl acetate copolymers (see column 7, lines 25+). With respect to the molecular weight of the polyethylene glycol (claim 4), column 6, lines 12+, teaches molecular weights that encompass the instantly claimed range. As for the molecular weight of the polysaccharide (claim 9) this appears to be a matter of obvious choice or design best determinable through routine experimentation and optimization within the art and producing no unexpected results, absent evidence showing otherwise as the reference teaches the use of similar types. As for claim 12 this claim reads on no defoamer being present. Claim 23 is met by the references disclosure of the types of thickening agents in column 7, lines 4+). Accordingly the instant claims are obvious over the reference.

Claim Rejections - 35 USC § 112

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 22-25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Art Unit: 1755

In claim 22 the phrase "the set and dried product" lacks proper antecedent basis.

Claims 23-25 contain improper Markush terminology as the phrase "at least one of the group consisting of" should be -- at least one selected from the group consisting of --.

Allowable Subject Matter

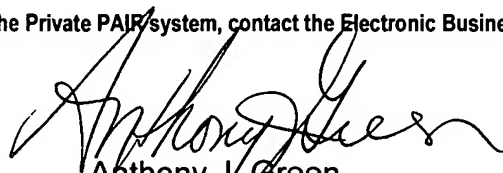
10. Claim 21 is allowed.

11. Claim 22 and 25 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony J. Green whose telephone number is 571-272-1367. The examiner can normally be reached on Monday-Thursday 6:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo can be reached on 571-272-1233. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Anthony J. Green
Primary Examiner
Art Unit 1755

ajg
April 04, 2006